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074022-3303  
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: DREWES et al.

Title: METHODS AND DEVICES FOR  
MASS TRANSPORT ASSISTED  
OPTICAL ASSAYS

Appl. No.: 09/675,518

Filing Date: September 19, 2000

Examiner: Marschel, Ardin H.

Art Unit: 1631

<b>CERTIFICATE OF MAILING</b> I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date below.  <u>Jodie M. Price</u> (Printed Name)  <u>[Signature]</u> (Signature)  <u>January 17, 2002</u> (Date of Deposit)
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#6  
Plunkett  
2/22/02

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to Office Action mailed December 17, 2001, please consider the following remarks.

In a restriction requirement, the Examiner has divided the claims into two groups:

Group I: claims 51-82; and  
Group II: claims 83-91.

Applicants hereby elect Group I, Claims 51-82, for examination, with traverse.

The Examiner has also required a species election to one type of diamond-like carbon within elected claim 58. Applicants hereby elect amorphous carbon with diamond-like properties, with traverse.

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Traversal of the Restriction Requirement

Notwithstanding the foregoing, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all currently pending claims.

A restriction requirement is proper if (1) two or more independent and distinct inventions are claimed in one application, and (2) there would be a serious burden on the examiner if restriction is not required. MPEP §803.

In the instant case, the Examiner has provided a *prima facie* showing that an undue search burden would exist if Group I and II were to be searched together (Paper No. 5, page 3). Nevertheless, Applicants respectfully disagree that an undue burden exists. The Examiner contends that the composition claims of elected Group I might be used in methods other than that recited in Group II. But this would indicate that the search for Group I, while potentially larger than that required for Group II, must still include the search required for Group II, each claim of which depends from an elected claim. Thus, by performing the search for Group I, the search required for Group II will have also been performed.

Therefore, because there is no serious burden placed upon the Examiner by examination of all pending claims, Applicants respectfully request that the Examiner withdraw the restriction and examine all of the claims on the merits.

Traversal of the Species Election Requirement

Applicants also respectfully request that the Examiner reconsider and withdraw the species election requirement for the elected group.

The MPEP provides that, if the members of the Markush group are so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. MPEP §803.02. In the present case, each member of the Markush group in claims 58

is a form of diamond-like carbon ("DLC"), a well-known term used to describe hard carbon films that can include both amorphous and crystalline phases. As noted in the instant specification, *e.g.*, on page 37, lines 4-26, DLC can exhibit properties of both diamond and graphite. In requiring election of a species, the Examiner has not indicated why examination of the entire Markush group, related to various DLC types, would impose a serious burden.

Applicants respectfully submit that a search and examination of each entire claim can be made without serious burden, and request that the Examiner withdraw the species election.

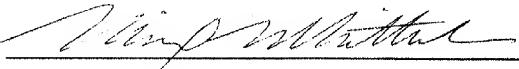
### CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the address and telephone number listed below so that they may be resolved without the need for additional action and response thereto.

Date January 17, 2022

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Respectfully submitted,

By 

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